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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,815	08/25/2003	Masahiro Sato	50212-525	1431
20277	7590	12/01/2004	EXAMINER	
MCDERMOTT WILL & EMERY LLP			THAI, LUAN C	
600 13TH STREET, N.W.			ART UNIT	
WASHINGTON, DC 20005-3096			PAPER NUMBER	
			2829	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,815

Applicant(s)

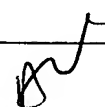
SATO, MASAHIRO

Examiner

Luan Thai

Art Unit

2829



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 10, 15, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/25/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information disclosure Statement filed on 8/25/03 has been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilliland et al (5,812,582).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 1, 2, 3, 5-8, 11-14, 16-18, Gilliland et al (see specifically figures 1-2) disclose a light emitting module comprising: a housing comprising mount

member (15) and a lens holding member (74); a semiconductor light emitting device (10) comprising a surface emitting type semiconductor laser and mounted on the mount member; a lens (70/66) held by the lens holding member (74), the lens having first surface which reflects part of light from semiconductor light emitting device and transmits part of the light, and a second surface which outputs the light transmitted by the first surface; and a semiconductor light receiving device (36) mounted on the mount member and arranged receive the reflected light from the first surface, wherein the mount member (15) has support surface provided along predetermined surface intersecting with predetermined axis, a hole extending in direction of the predetermined axis, and lead terminal (22) penetrating the hole, and wherein the lens holding member is placed on the support surface of the mount member so as cover the semiconductor light emitting device and the semiconductor light receiving device, wherein the light emitting surface of the light emitting device is provided along another surface intersecting with the predetermined axis, and wherein the semiconductor light receiving device has a light receiving surface for receiving said reflected light, and wherein the light receiving surface is provided along another surface intersecting with the predetermined axis.

Gilliland et al. further disclose the lens having a reflecting film capable of reflecting part of the light from the semiconductor light emitting device and transmitting part of the light, on the first surface, and wherein the reflecting film further demonstrates the reflectance of not less than 5% and not more than 30% (Col. 7, lines 36+). Gilliland et al. also disclose the lens (70) being a ball lens, and an optical fiber (96) optically coupled to the second surface of the lens and held by the housing.

Allowable Subject Matter

5. Claims 4, 9-10, 15 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art taken either singly or in combination fails to anticipate or fairly suggest, among others, at least: a) *a distance between a light receiving surface of the semiconductor light receiving device and the component mounting surface is larger than a distance between a light emitting surface of the semiconductor light emitting device and the component mounting surface*, as recited in claims 4 and 15; b) *the semiconductor light emitting device has a luminescence intensity profile having a peak intensity at a predetermined angle of inclination from the optical axis of the semiconductor light emitting device*, as recited in claims 9 and 19; and c) *the semiconductor light receiving device comprises a semiconductor chip with a hole extending in the direction of the predetermined axis, and a light receiving portion provided in the semiconductor chip and along a closed curve surrounding the predetermined axis, and wherein the semiconductor light emitting device is housed in the hole of the semiconductor light receiving device*, as recited in claims 10 and 20.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan Thai whose telephone number is 571-272-1935. The examiner can normally be reached on 6:45 AM - 4:15 PM, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 571-272-1812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Luan Thai

Primary Examiner
Art Unit 2829
November 24, 2004